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| 10/706,427 | 11/12/2003 | James R. January | 14045.015US | 7160 |
| 25461 7590 12/18/2007 SMITH, GAMBRELL & RUSSELL SUITE 3100, PROMENADE II 1230 PEACHTREE STREET, N.E. ATLANTA, GA 30309-3592 | | | | |
| EXAMINER MATZEK, MATTHEW D | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1794 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,427

Applicant(s)

JANUARY, JAMES R.

Examiner

MATTHEW D. MATZEK

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 13-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 13-17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

1. The amendment dated 10/11/2007 has been fully considered and entered into the Record. The amended claims contain no new matter. Claims 9-12, 18, 24 and 25 have been canceled. Claims 1-5, 7, 8, 13-17 and 19-22 are currently active. The previously applied 112 rejections have been withdrawn either due to amendment or the cancellation of the applicable claim.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 3-5, 6-12, 14-17, 19-22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lovell (US 5,629,073).

a. Lovell teaches a coated substrate comprising a coating composition and a substrate (pg.1 col.2 lines 6-7). The coated substrate can have a flexible material of cotton. The canvas limitation of claims 3 and 4 are anticipated without further structural limitations for said limitation. The coating composition is about 20-30 and even up to 80 weight percent latex, about 5 to about 50 weight percent dry ingredients, and about 20-30 and as little as 5 to as much as 70 weight percent water (pg.4 col.7 lines 1-7). The coating is a latex and water paint mixture (pg.3 col.5 lines 13-14) comprising surfactants in about 0.1% by weight (pg. 4 col.7 line 34), fillers and extenders (pg.3 col.5 lines 19), defoaming agents in small amounts of up to 0.5% (pg.3 col.6 line 54), dispersing agents (pg.3 col.5 line 54), and pigments such as calcium carbonate and talc (pg.3 col.6 lines 18-21). The extenders can be talc, in about 1 percent by weight (pg.3 col.6 lines 19-20). The aqueous latex paint dispersion, which is hydrophilic, may comprise polyvinyl alcohol or

polyvinylpyrrolidone (pg.3 col.5 lines 33-59). From Applicant's specified amounts, the following percentages were calculated: 100-200 parts by weight latex, 57-48.5% by weight; 0-5 parts pigment dispersant, 0-1.2%; 0-2 parts defoamer, 0-0.49%; 75-100 parts pigment and filler, 43-24.3%; 0-50 parts extender, 0-12.1%; 0-5 parts surfactant, 0-1.2%, 0-50 parts water, 0-12.1%. Thus, claims 1, 3-12, 14-17, and 19-22 are anticipated. The new claim preamble of "artist's canvas" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The claim limitation that requires the coating to be hydrophilic is provided by the Lovell reference because the latex coating is aqueous and is therefore inherently hydrophilic and remains so after drying. Furthermore, a well known benefit of latex coatings is their ability to be cleaned and washed (i.e. latex paints). Even though Lovell does not explicitly disclose that the latex coating formulation accepts watercolor paints, pencils, and inks in and on the coating or that the coating allows for the removal of the watercolor paints, pencils, and inks without harming the coating by wetting the coating and wiping off the watercolor paints, pencils and inks the applied reference would exhibit the claimed properties because they are inherent properties of latex coatings and paints.

b. Examiner notes that claims 9 and new claim 24 utilize the term “consisting essentially of”. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355.

Claim Rejections - 35 USC § 103

3. Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lovell (US 5,629,073).

a. Lovell fails to teach the use of woven substrates, but does teach that the substrate can be any one of a variety of pliable and fabric-like textile products including those intended for use as garments, wall coverings, floor coverings or the like (col. 3, lines 3-10). It would have been obvious to choose a woven substrate based upon its ability to provide improved structural integrity.

b. Lovell is silent about the specific amount of pigment dispersant, the amount of calcium carbonate included in the paint mixture, and the amount of the water-soluble polymer, which is mixed with the paint mixture. Lovell also fails to teach that the coating comprises a defoamer of 0.3 percent by weight, a surfactant of 0.63 percent by weight, and talc (as the extender) of 6.3 percent by weight of the total paint composition. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the desired percentages through the process of routine experimentation in order to arrive at values, *In re Aller*, 105 USPQ 233., which offered the optimum composition in the invention of Lovell. Thus, claims 13 and 18 are rejected.

Response to Arguments

4. Applicant's arguments filed 10/11/2007 have been fully considered but they are not persuasive.
5. Applicant argues that in light of the amended claims the previously applied rejections are moot. Examiner disagrees and has set forth his interpretation of the applied art and rejections *supra*.
6. Applicant argues that Lovell and the instantly claimed invention are for entirely different types of coatings used for entirely different processes. Examiner would like to point out that Lovell provides for the claimed composition and would thereby provide the desired paint/pencil/ink application and removal properties. Since Lovell is capable of being used as an artist's canvas the original intended use is immaterial.
7. Applicant argues that the composition of Lovell is not identical to the claimed formula, it is not used on the same substrate, it does not have the same function, and it does not disclose every element of the present independent claims. Lovell has not been used to reject all independent claims (claim 13). For the remaining independent claims, Examiner has set forth how Lovell anticipates the claimed coating composition, would necessarily possess the claimed properties and may be used in the claimed function.
8. Applicant argues that only references from arts analogous to that of the claimed invention may comprise prior art to the claimed invention. A holding of obviousness can be based on a showing that there was "an apparent reason to combine the known elements in the fashion claimed." KSR, 127 S. Ct. at 1740-41, 82 USPQ2d at 1396. In other words, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

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obviousness.” Id., 127 S. Ct. at 1741, 82 USPQ2d at 1396 (quoting In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). However, this reasoning is not limited to the problem the patentee was trying to solve; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (emphasis added). Claim 2 has been rejected that it is well known and therefore obvious to replace a “fabric-like” substrate with a woven substrate based upon an improvement in the article’s structural integrity. Claim 13 was rejected *supra* based upon a motivation to optimize a given formulation of which the claimed constituent materials are anticipated by Lovell.

9. Applicant argues that fundamental properties of the claimed and applied inventions are not even close to being the same. As Examiner has set forth in the rejection and response to argument section of this Office Action, the claimed and applied references have overlapping coating compositions and the latex coating of Lovell would possess the claimed properties.

10. Applicant argues that Examiner has failed to consider the Lovell reference as a whole and that the remaining aspects of Lovell would disqualify it under 35 USC §103. Applicant has exclusively used open-ended language in claiming the present invention and as such additional components may be present. The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004). The additional components required by Lovell for enablement do not preclude its use in the claimed manner and Applicant

has failed to demonstrate how Lovell with its latex coating would fail to perform as the claimed "artist's canvas".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MATTHEW D. MATZEK** whose telephone number is (571)272-2423. The examiner can normally be reached on M-F, 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571.272.1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew D Matzek/
Examiner, Art Unit 1794

/Norca L. Torres-Velazquez/
Primary Examiner, Art Unit 1794